IN THE SUPREME COURT OF THE UNITED STATES.

THE UNITED STATES *ex Rel.* ALFRED L. BERNARDIN, *Plaintiff in Error,* *vs.* BENJAMIN BUTTERWORTH, Commissioner of Patents.	October Term, 1897. No. 404.

In re Motion to substitute Hon. C. H. Duell, Present Commissioner of Patents, as Defendant in Error in Place of the Hon. Benjamin Butterworth, Deceased.

STATEMENT OF FACTS.

The Commissioner of Patents, March 23, 1895, on appeal in an interference proceeding between applications of Alfred L. Bernardin and his employee, William H. Northall, decided that Bernardin is the inventor and is entitled to a patent for the invention involved in the interference. Appeal from this decision was taken by Northall to the Court of Appeals of the District of Columbia, which Court reversed the decision of the Commissioner.

Mandamus proceedings were then commenced by Bernardin in the Supreme Court of the District of Columbia, to compel the Commissioner to issue a patent in accordance with his decision, on the ground that, notwithstanding the Act of Congress, approved February 9, 1893, in form, confers jurisdiction upon the Court of Appeals of the District of

Columbia to hear the appeal on error prosecuted from the action of the Commissioner of Patents, an officer of the executive department of the Government, and to review the official action of said officer of the executive department and to revise or reverse or nullify said action, said statute is, to the extent that it attempts to confer jurisdiction upon the Court of Appeals of the District of Columbia to review, reverse, or nullify the action of the executive branch of the Government, unconstitutional, inoperative and void, and the decision rendered and certified in that behalf *coram non judice* for want of constitutional authority to entertain, hear, and control by judicial action the official acts of the executive department. (Transcript, p. 5.)

The Supreme Court of the District of Columbia dismissed the petition for mandamus; and an appeal from this dismissal was taken by Bernardin to the Court of Appeals, which court sustained the dismissal of the petition for mandamus, but, at the same time, said they " were *not without doubt* in respect of the soundness " of their judgment as to the constitutionality of the law in question (Bernardin *vs.* Seymour, 79 O. G., 1190).

Writ of error would then have been taken to the Supreme Court, and it was so understood when the decision of the Court of Appeals was rendered; but *Commissioner Seymour* almost immediately *resigned* his office. Bernardin was compelled to pay costs and, on account of this resignation, to commence proceedings *de novo*.

On April 12, 1897, Benjamin Butterworth became Commissioner. The new petition for mandamus was filed in the Supreme Court of the District of Columbia, April 17, 1897, and this was dismissed. Appeal was then taken to the Court of Appeals; and the decision of the Supreme Court of the District of Columbia was affirmed May 11th upon the grounds set forth in the opinion in Bernardin *vs.* Seymour.

Bernardin was again compelled to pay costs.

On May 25, 1897, a writ of error was allowed to the Supreme Court of the United States and the case has proceeded to the printing of the record and preparation for hearing on its merits.

On January 16, 1898, *Commissioner Butterworth deceased;* and the present motion asks leave of the Court to substitute the present Commissioner, Charles H. Duell, in his stead.

Commissioner Duell consents to this substitution.

It will thus be seen that Bernardin has been compelled to pay costs *twice;* and the question now arises whether he should *again* be compelled to incur the same costs in order to get the case before Your Honors. *If this motion is overruled,* it can *have no other effect.*

POINTS.

There are three cases pertinent to be considered in relation to the case at bar. We will discuss them in order.

They are—

The Secretary *vs.* McGarrahan, 9 Wall., 298;
United States *vs.* Boutwell, 17 Wall., 604;
Thompson *vs.* United States, 103 U. S., 480.

In The Secretary *vs.* McGarrahan, 9 Wall., 298, Browning, the Secretary, *resigned four months before the decision* of the Supreme Court of the District of Columbia, but the mandamus was directed to him *or to his successor in office.* No notice or other steps were taken to make Cox, his successor, a party. There was no question of substitution. One of the

grounds, if not the main ground, for the decision, found in the language of Mr. Justice Clifford, is:

> "* * * the present Secretary may well complain that he is adjudged to be in default though he never refused to allow the relator to purchase the land, and that the judgment was rendered against him without notice and without any opportunity to be heard.
>
> "Notice to the defendant, actual or constructive, is essential to the jurisdiction of all courts, * * *."

This reason, of course, does not apply where the question is one of substitution and the party to be substituted voluntarily submits thereto, as in the case at bar.

United States *vs.* Boutwell, 17 Wall., 604, might be considered a precedent for the case at bar, except that the official to be substituted *opposed the substitution.* A mandamus was refused by the Supreme Court of the District of Columbia to compel Boutwell, Secretary of the Treasury, to pay an order. *After error was taken to the Supreme Court,* Boutwell resigned, and Richardson was appointed. *Counsel moved for leave to substitute Richardson.* No demand had been made on *Richardson* to pay the draft, and he *opposed* the substitution. Speaking by Mr. Justice Strong, the Court said (italics mine):

> "But no matter out of what facts or relations the duty has grown, what the law regards and what it seeks to enforce by a writ of mandamus, is the *personal obligation* of the individual to whom it addresses the writ. If he be an officer, and the duty be an official one, still the writ is aimed exclusively against him as a person, and he only can be punished for disobedience. The writ does not reach the office. It cannot be directed to it. It is, therefore, in substance a personal action, and it rests upon the averred and assumed fact that the defendant has neglected or refused to perform a

personal duty, to the performance of which by him the relator has a clear right. Hence it is an imperative rule that previous to making application for a writ to command the performance of any particular act, *an express and distinct demand or request to perform it must have been made* by the relator or prosecutor upon the defendant, and it must appear that he *refused to comply* with such demand, either in direct terms or *by conduct from which a refusal can be conclusively inferred.* Thus it is the personal default of the defendant that warrants impetration of the writ, and if peremptory mandamus be awarded, the costs must fall upon the defendant.

"It necessarily follows from this, that on the death or retirement from office of the original defendant, the writ must abate in the absence of any statutory provision to the contrary. When the personal duty exists only so long as the office is held, the court cannot compel the defendant to perform it after his power to perform has ceased. And if a successor in office may be substituted, he may be *mulcted in costs for the fault of his predecessor, without any delinquency of his own.* Besides, were a demand made upon him, he might discharge the duty and render the interposition of the court unnecessary. At all events, he is not in privity with his predecessor, much less is he his predecessor's personal representative. As might be expected, therefore, we find no case in which such a substitution as is asked for now has ever been allowed in the absence of some statute authorizing it. * * *

"And, even if the retirement of the defendant from office and his consequent inability to perform the act demanded to be done does not abate the writ, or necessitate its discontinuance, there is still an insuperable difficulty in the way of our directing the substitution asked for. *We can exercise only appellate power.* We have no original jurisdiction in the case. But any summons issued, or *rule* upon Mr. Richardson requiring him to become a party to the suit, would be the exercise of *original jurisdiction* over both a new party and a

new cause, for the duty which he would be required to perform would be his own, not that of his predecessor."

It will be seen that the argument made by the court—that the party to be substituted might be mulcted for costs without fault of his own—can have no force where demand has been made upon such party and he refuses to comply therewith, or where, as in the case at bar, he voluntarily submits to the jurisdiction. Nor does it seem to be sound in the case at bar for another reason; for, as counsel is informed, there can be little doubt that, were it necessary, the costs of the present suit would be defrayed out of the *contingent fund* of the *Interior Department* or out of the amount provided by the annual appropriation acts. (See Act of February 19, 1897, 29 Stats. at L., 569, etc.) "For investigating the question of the public use or sale of inventions for two years or more prior to filing applications for patents, and for *expenses attending defense of suits instituted against the Commissioner of Patents.*" And certainly the Government would not be wronged by the substitution, because, whatever costs it had to pay in any event would be due to an act of one or the other or both of its officers, through whom equally it acts and for whose actions equally it should be responsible.

Moreover, in the case at bar, it cannot be said that the present Commissioner has not had demand made upon him or refused to comply with that demand "by conduct from which a refusal can be conclusively inferred;" for he *voluntarily submits* to the substitution of his name as party defendant.

As to the other objection, it will be observed that, in the case at bar, there need be no exercise of *original* jurisdiction in the shape of a "rule" upon the new Commissioner; for he *voluntarily* becomes a party. And the only exercise of

power by the Court, even should the lower court be overruled, will be, it would seem, an exercise of *appellate* jurisdiction.

Moreover, the question arises whether the case at bar does not come within the exception expressly laid down by the Court in its opinion: that is, are not such suits, in the District of Columbia, excepted by *statute* from abatement by death?

In this connection, let us look at the 80th chapter, section 1, of the Maryland Act of 1785, which became law in the District of Columbia at the time of the cession thereof for the seat of government (italics mine):

> "*No* action, brought or to be brought, in any court of law in this District [State] *shall* abate by the *death* of *either of the parties* to such action, but upon the death of any defendant, in a case *where the action by such death would have abated before this act*, the action shall be continued, and the heir, devisee, executor or administrator, of the defendant, as the case may require, *or other person interested on the part of the defendant may* appear to such action; * * * ."

This statute does not seem to have been called to the attention of the Court when U. S. *vs.* Boutwell was decided.

It is true that this statute uses the words "heir," "devisee," etc., as the persons who are to be substituted, but this, we submit, is because such persons are the ones most commonly substituted for a deceased party; and that the statute was not intended to be limited to them is seen from the use of the expression "or other person interested on the part of the defendant." The spirit, if not the wording, of this phrase covers the case at bar; and this, especially, when we consider that the act says; "*No* action * * * shall abate * * * in a case *where the action by such death would have abated before this act* * * * ." Moreover, the use of the word "shall" in the first part of the act and

"may" in the latter part is significant as showing an intent that *no* action shall abate and an *enumeration* merely of *some*, but not of all, persons who *may* be substituted.

In Thompson *vs.* U. S., 103 U. S., 480, a mandamus was issued against a clerk of a township in Michigan to compel him to make and deliver to the supervisor a certified copy of a judgment against the township in order that it might be placed upon the tax-roll for collection. The clerk resigned before the rule to show cause was served on him, and set up this as a defense. The case came up to the Supreme Court on writ of error.

The Court, speaking by Mr. Justice Bradley, said (italics mine):

> "But *we cannot accede to the proposition that proceedings in mandamus abate by the expiration of the term of office of the defendant where*, as in this case, *there is a continuing duty irrespective of the incumbent*, and the proceeding is undertaken to enforce an obligation of the corporation or municipality to which the office is attached. * * * The proceedings may be *commenced with one set of officers and terminate with another*, the latter being bound by the judgment. * * *
>
> "If the resignation of the officer should involve an abatement, *we would always have the unseemly spectacle of constant resignations and reappointments to avoid the effect of the suit.* * * *
>
> "*The cases in which it has been held by this Court that an abatement takes place by the expiration of the term of office have been those of officers of the Government*, whose alleged delinquency was *personal*, and did not involve any charge against the Government whose officers they were. *A proceeding against the Government would not lie.* The Secretary *vs.* McGarrahan, 9 Wall., 298; United States *vs.* Boutwell, 17 *Id.*, 604"

It will readily be seen that many of the reasons assigned by the Court in Thompson *vs.* U. S. for holding that the suit *did not abate*, apply equally in U. S. *vs.* Boutwell (as well as

in the case at bar) where they held that it *did abate;* and, indeed, the *only* reason of any weight that can be or was assigned for the distinction between the rulings in the two cases is that a mandamus proceeding against an officer of the Government is *especially personal* because the *Government itself cannot be sued.* But it would seem as if this argument loses much, if not all, of its weight in the case at bar when we consider that the present Commissioner voluntarily submits to the substitution of his name and to any judgment or costs that may result therefrom. Moreover, it will be noted, by an examination of the opinion in U. S. *vs.* Boutwell, that the ground—that the Government cannot be sued—alleged in the opinion in Thompson *vs.* U. S., as shown in the last paragraph above quoted, for the distinction between that case and U. S. *vs.* Boutwell, *was not even hinted at in U. S.* vs. *Boutwell itself* as a reason therefor.

Three other decisions have been rendered by Your Honors, to which we will briefly call your attention. Two of these are memorandum decisions: U. S. *ex rel.* Long *vs.* Lochren, 164 U. S., 701, and U. S. *ex rel.* Warden *vs.* Chandler, 122 U. S., 643. They both were dismissed *on the authority of U. S.* vs. *Boutwell.* In *all* these cases, unlike the case at bar, *there was no consent to the substitution.*

The other case is Warner Valley Stock Company *vs.* Smith, 165 U. S., 28, which was a suit in equity for an injunction, which was in effect a mandamus, filed in the Supreme Court of the District of Columbia against Hoke Smith, Secretary of the Interior, and Silas W. Lamoreaux, Commissioner of the General Land Office. The Court held that the suit abated upon the resignation of Smith and *could not be prosecuted against Lamoreaux alone.* Smith was, in fact the main party to the suit. The case is not directly in point, except that, as to Secretary Smith, though the case was in equity and not a mandamus proceeding, the Court applied the rule of abatement laid down in U. S. *vs.* Boutwell, thus

substantially reaffirming the soundness of that rule in mandamus proceedings against Government officers. It will be noted that the appellees defended, and *did not consent;* and that the Court simply ordered that the case be remanded with directions to *dismiss the bill for want of parties.*

The three cases, not above referred to but cited in Mr. Justice Gray's opinion in Warner Valley Stock Co. *vs.* Smith, *supra*, viz: Commissioners *vs.* Sellew, 99 U. S., 624; U. S. *vs.* Schurz, 102 U. S., 378, 408; and U. S. *vs.* Lamont, 155 U. S., 303, 306, will be seen, upon examination, not to be in point.

In Commissioners *vs.* Sellew, the writ was against a county and was directed to it in its corporate name; and the only real question was whether the "writ was properly directed to the board in its corporate capacity."

In U. S. *vs.* Schurz, the question was whether the case presented *entitled petitioner to a mandamus* to compel the delivery of a patent to certain public lands, or whether he was still clothed with discretion.

In U. S. *vs.* Lamont, quoting from the syllabus, it was held:

> "* * * the Secretary of War cannot be required by mandamus to sign a contract for the performance of work by a party who is already under written contract with him to perform the same work for the Government at a lower price and under different conditions."

Upon this showing, we respectfully submit that this motion ought to be allowed, and that it can be allowed without overruling any of the former decisions of the Court; while, at the same time, Your Honors will be doing an act of justice in relieving the relator of the onerous burden of being *compelled to pay costs for the third time*, with possibly a repetition of this requirement indefinitely.

Respectfully submitted,

JULIAN C. DOWELL,

Attorney for Bernardin.

Reply to Briefs Filed in Opposition to Motion for Substitution.

What has already been said seems to be a sufficient answer to the brief filed by counsel for the Crown Cork and Seal Company, a Baltimore corporation interested in defeating the issue of a patent to Bernardin.

A brief in opposition has also been filed by the Hon. John K. Richards, Solicitor-General, in view of which the following suggestions are respectfully submitted.

The opening statement of the brief of the Hon. Solicitor-General indicates an apparent misconception of the origin of this case and the merits thereof.

The case grows out of a contest between Alfred L. Bernardin, president and superintendent of the Bernardin Bottle Cap Company, of Evansville, Indian, manufacturers of bottle-sealing devices, and a salaried employee of the Bernardin Company, acting in the interest of the Crown Cork and Seal Company, a competitor of the Bernardin Company, in the manuafacture of bottle caps or bottle-sealing devices (one of which devices is the subject of this controversy). (Transcript, pages 25 and 45 *et seq.*)

The record shows that Bernardin filed an application for a patent for a bottle-sealing device, which was allowed, though the patent did not issue immediately, because, in contemplation of taking out foreign patents, Bernardin deferred for a few months after notice of allowance the payment of the final Government fee (six months from the official notice of allowance being allowed by law for this purpose) and, in the meantime, knowledge of Bernardin's invention was brought to the attention of the Crown Cork and Seal Company, whose secretary and business manager, William Painter, filed an application for a patent for the same invention, and thereafter,

through a correspondence between the representative of the aforesaid corporation and the attorney of the said Northall, the latter filed an application for a patent, which was also placed in interference with Bernardin. (Transcript, pages 25 and 45.) This interference was decided by the Commissioner of Patents in favor of Bernardin; but, on appeal to the Court of Appeals of the District of Columbia, the decision of the Commissioner was reversed, whereupon mandamus proceedings were instituted as herein before recited.

The question involved is one of great importance, not only to Bernardin, but the general public, and the Hon. Benjamin Butterworth, as Commissioner of Patents, while denying the request of Bernardin to have the patent issue to him in accordance with the decision of Mr. Butterworth's predecessor, Hon. John S. Seymour, solely because of the decision of the Court of Appeals, expressed the opinion that the statute conferring jurisdiction on said court in such cases is *unconstitutional*, "*because it confuses and obliterates the lines which mark the boundary between the several departments of the Government and makes one subordinate to another.*" (Transcript, p. 8.)

And in conclusion Mr. Butterworth said—

> "I trust if any step is to be taken it may be done immediately, in order that no time be lost in having this question finally settled." (*Ibid.*, p. 10.)

And the importance of the question and the desirability of having it speedily determined by this Court is shown by the concluding clause of the opinion of the Court of Appeals of the District of Columbia, wherein the Court said—(italics mine):

> "Without further prolonging the discussion of this interesting question, and *admitting that we are not without doubt in respect of the soundness of our judgment*, we

repeat that we have not been able to see our way to the conclusion urged upon us—namely, that the act conferring the right of appeal to this court from the decisions of the Commissioner of Patents is beyond the power of Congress to enact, for the reason that it oversteps the boundaries erected by the Constitution between the three great departments of the Government."

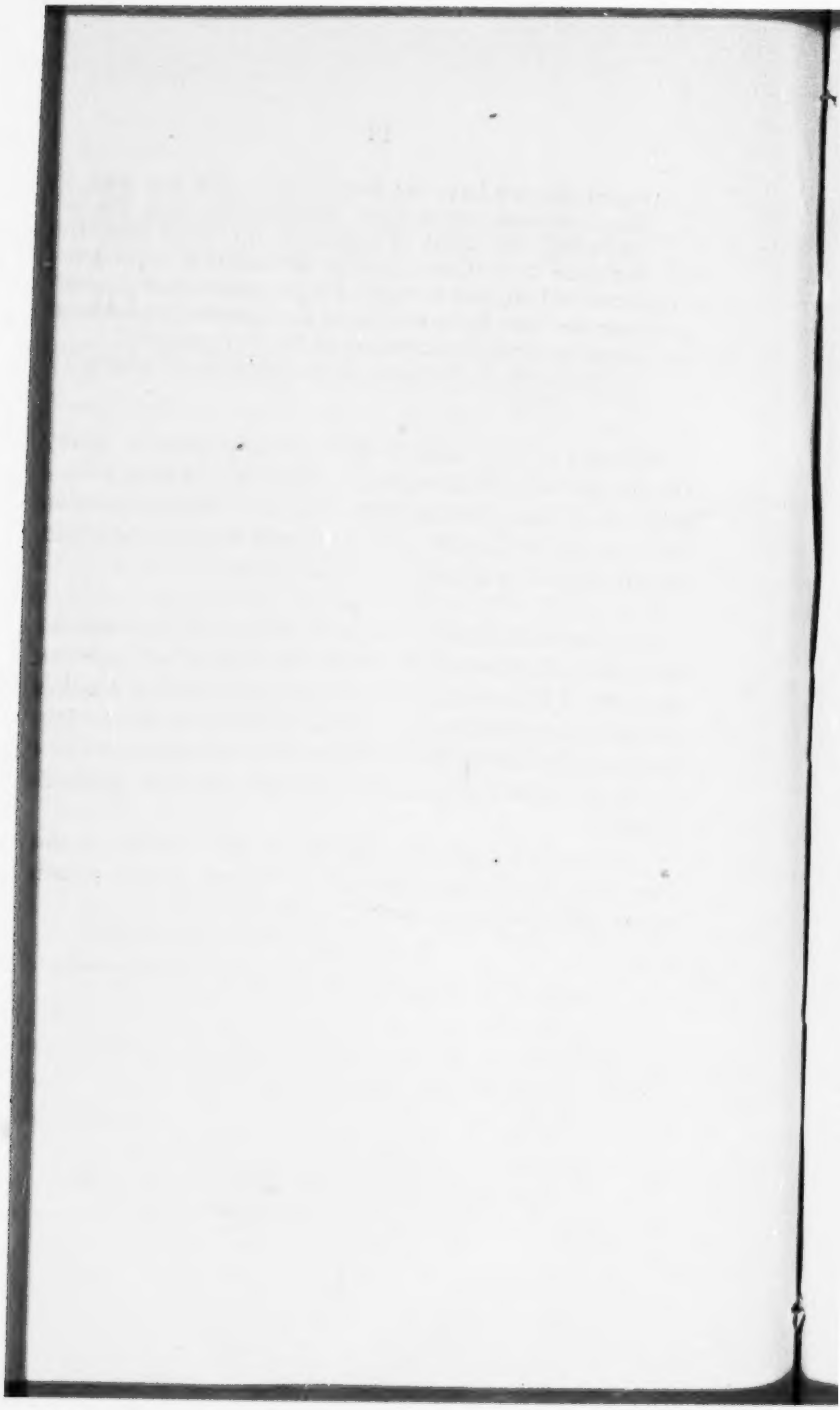
(Bernardin *vs.* Seymour, Commissioner of Patents, 79 O. G., 1194.)

A denial of this motion will not only place a heavy burden on Bernardin, compelling him to pay costs a *third time*, but it defers the determination of a mooted question, which, I submit, should be speedily and finally determined by this Court in the interest of the public.

If this action and all subsequent actions of like character are to abate because of the *resignation* or *death* of the Commissioner of Patents, it is exceedingly problematical whether the case will ever be brought before this Court for its decision, for the reason that the office of Commissioner of Patents is subject to frequent and periodical changes by resignations or otherwise.

I respectfully submit, in view of the consent of the Hon. C. H. Duell, Commissioner of Patents, to the substitution, that the motion should be granted.

JULIAN C. DOWELL,
Attorney for Alfred L. Bernardin.



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PROFESSIONAL STATEMENT.

In an interview with the Solicitor-General subsequent to the filing of his opposition to the motion for a substitution of Mr. Duell for Mr. Butterworth, he stated to me, and consented that I say to the Court, that his objection to the granting of the motion is based solely on the legal ground that, under the law as construed by this Court the action has abated by the death of Mr. Butterworth; that he understands the Patent Office earnestly desire to have the constitutional question involved in the controversy finally settled; and that if it shall seem proper to the Court, under the special circumstances of this case, to grant the motion, he does not object thereto.

Very respectfully,
JULIAN C. DOWELL,
Attorney for Bernardin.